

## **REMARKS**

In this Amendment, Applicant has amended claims 6 and 8 to more appropriately define the present invention. Claims 1-17 are pending in the present application, of which claims 6-11 are presented for examination.

In the Office Action, the Examiner rejected claims 6 and 8 under 35 U.S.C. § 102(b) as being anticipated by Thiessen et al. (U.S. Patent No. 5,232,638) and “optionally as evidence from teachings” of Brooks et al. (U.S. Patent No. 5,759,680) or Hong (U.S. Patent No. 6,344,077) (Office Action at page 2); rejected claims 7 and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Thiessen et al. in view of Pellegrin et al. (U.S. Patent No. 5,900,206); and rejected claim 9 under 35 U.S.C. § 103(a) as unpatentable over Thiessen et al. in view of Bakshi et al. (U.S. Patent No. 5,736,475).

Applicant respectfully traverses the rejections of claims 6-11, as detailed above, for the following reasons.

### **Rejection under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claims 6 and 8 under 35 U.S.C. § 102(b) as being anticipated by Thiessen et al. and “optionally as evidence from teachings” of Brooks et al. or Hong (Office Action at page 2) for the following reasons.

In order to properly anticipate Applicant’s claimed invention under 35 U.S.C. § 102(b), the Examiner must show that each and every element of each of the claims in issue is found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. §2131, page 2100-69, 8th Ed., August 2001, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9

U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Further, “the elements must be arranged as required by the claim.” M.P.E.P. §2131, p. 2100-69.

Applicant notes the Examiner’s suggestion to “add limitation in dependent claim 2 to independent claim 6 and independent claim 8 to define over the art of record.” Office Action at page 4. Although Applicant respectfully disagrees that any claim amendments are necessary to “define over the art of record,” Applicant has amended claims 6 and 8 to recite “particles of silicon dioxide” (see claim 2) in an effort to advance prosecution of this case. Thiessen et al. is silent as to the “particles of silicon oxide,” as recited in claims 6 and 8, nor is there any suggestion in Thiessen et al., Brooks et al., or Hong of such particles. Thus, in view of these shortcomings of Thiessen et al., and further in light of the Examiner’s comments on page 4 of the Office Action, Applicant submits that claims 6 and 8 are allowable.

#### **Rejection under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 7 and 9-11 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established by the Examiner.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

### **I. Claims 7 and 10-11**

The Examiner rejected claims 7 and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Thiessen et al. in view of Pellegrin et al. Applicant respectfully traverses the rejection for the following reasons.

First, claim 7 depends from claim 6 and claims 10-11 depend from claim 8. As discussed above, regarding the rejection of claims 6 and 8 under 35 U.S.C. § 102(b), Thiessen et al. does not teach or suggest each and every element of claims 6 and 8. Pellegrin et al. fails to cure this deficiency. Specifically, Pellegrin et al. fails to teach or suggest at least “the hygroscopic agent comprises particles of silicon dioxide,” as recited in claims 6 and 8.

Therefore, at least because Thiessen et al. and Pellegrin et al., either taken alone or in combination, fail to teach or suggest each and every element of independent claims 6 and 8, the Examiner has failed to establish a *prima facie* case of obviousness for claims 7 and 10-11, which depend from claims 6 and 8. Accordingly, Applicant respectfully submits that claims 7 and 10-11 are also allowable at least in view of their dependence from allowable claims 6 and 8.

Further, while the Examiner admits that “Thiessen et al. does not teach the limitations (i.e. the application of 1<sup>st</sup> and 2<sup>nd</sup> centrifugal spinners recited in claim 7” (Office Action at page 3), the Examiner attempts to cure this deficiency by stating that “such would have been obvious in the art as such is well known in the art as exemplified in the teachings of Pellegrin et al. (figures 1-3).” Office Action at page 3. Applicant respectfully disagrees.

The M.P.E.P. clearly states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” M.P.E.P. § 2143.01 (emphasis in original). The M.P.E.P. further states that “[a] statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” M.P.E.P. § 2143.01 (emphasis in original). Since the Examiner has failed to provide any teaching from either Thiessen et al. or Pellegrin et al., or any other objective reason, that suggests the desirability of combining the teachings of the two references, the Examiner has failed to establish a *prima facie* case of obviousness for claim 7.

## **II. Claim 9**

The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Thiessen et al. in view of Bakshi et al. Applicant respectfully traverses the rejection for the following reasons.

Claim 9 depends from claim 8. As discussed above, regarding the rejection of claim 8 under 35 U.S.C. § 102(b), Thiessen et al. does not teach or suggest each and every element of claim 8. Bakshi et al. fails to cure this deficiency. Specifically, Bakshi et al. fails to teach or suggest at least “the hygroscopic agent comprises particles of silicon dioxide,” as recited in claim 8.

Therefore, at least because Thiessen et al. and Bakshi et al., either taken alone or in combination, fail to teach or suggest each and every element of independent claim 8, the Examiner has failed to establish a *prima facie* case of obviousness for claim 9, which depends from claim 8. Accordingly, Applicant respectfully submits that claim 9 is also allowable at least due to its dependence from claim 8.

**Conclusion**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 2, 2004

By: Rajeev Gupta  
Rajeev Gupta  
Reg. No. 55,873